

REMARKS

Claim 1 is amended herein for purposes of further clarification without changing its scope. Support for the Amendment is found, for example, in the paragraph bridging pages 5-6 of the specification. No new matter is presented.

Applicant submits that entry of the Amendment is proper since the amendment complies with an objection or requirement as to form in that the amendment further clarifies that the optical recording medium of the present invention has one of the "another substrate" and the "another layer" with respect to the objection to the drawings discussed below. See MPEP § 714.12 which states, "amendments filed after a final rejection, but before or on the date of filing an appeal, complying with objections or requirements as to form are to be permitted after final action in accordance with 37 C.F.R. §1.116(b)".

Accordingly, Applicants respectfully request entry and consideration of the Amendment. Upon entry, claims 1-10 will be all of the claims pending in the application.

II. Response to Objection to the Drawings

On page 2 of the Office Action, in paragraph 1, the Examiner has objected to the newly submitted drawings, Figures 4 and 5, because the drawings must show every feature of the invention specified in the claims. The rejection on page 2 indicates that Figures 4 and 5 are not accepted for two reasons: (1) it contains new matter as described in the following "new matter" rejection and (2) the drawings are objected to under 37 C.F.R. § 1.83(a) for failing to show every feature of the invention specified in the claims. Specifically, the Examiner indicates that

the "another layer having a shape that is substantially the same as that of the transparent substrate" must be shown or the features canceled from the claims.

First, Applicant notes that there is no "new matter" rejection in the Action and the Examiner was contacted by telephone to clarify this matter. During that telephone conversation, the Examiner indicated that the drawings are objected to based on the alleged failure to show the "another layer" and not because of new matter. A Statement of Substance of Interview is submitted herewith; however, the Examiner is requested to confirm this as a matter of record.

As for the non-accepted drawings, Applicant submits that the amendment to claim 1 makes it clear that it is sufficient for the optical recording medium of the present invention to have one of the "another substrate" and the "another layer". Therefore, the present invention includes an embodiment in which "another substrate" is present but "another layer" is not present, as well as an embodiment in which "another layer" is present but "another substrate" is not present. Thus, Applicant respectfully requests entry of Figures 4 and 5 previously submitted with the Amendment filed on May 11, 2005 and withdrawal of the objection to the drawings.

III. Response to Claim Rejections under 35 U.S.C. § 103

Claims 1 and 4-10 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Itoigawa et al (JP 9-69239) in view of O'Brien (US 6,775,839).

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Itoigawa et al (JP 9-69239) in view of O'Brien (US 6,775,839) as applied to claim 1, further in view of Takemura et al (US 5,809,007).

Applicant respectfully traverses the rejections as follows.

The Examiner notes that Itoigawa et al does not show a second adhesive layer which is formed on a portion of the transparent substrate, wherein the portion resides between an edge portion of the center hole and whichever of an inner circumferential portion of a region having the reflective layer formed thereon and an inner circumferential portion of a region having the first adhesive layer formed thereon is closer to the center hole.

To remedy this deficiency, the Examiner relies on O'Brien for the alleged teaching of an optical recording medium wherein a second adhesive layer (93) is formed on a portion of the substrate.

To the contrary, Applicants submit that O'Brien teaches an optical storage device having an optically-transparent substrate, a reflective layer and a print layer. The print layer has a first print layer surface bonded to the reflective layer surface and a second print layer surface (claim 1 of O'Brien). O'Brien specifically teaches layer constitutions in which an "EAS tag (91)" is fixed on either a protective layer (87) or a reflective layer (83') via an adhesive layer (93). See Figures 7-11 of O'Brien.

Item 4 of the Action dated February 8, 2006 states that O'Brien teaches an adhesive layer (93) formed on a substrate (80) via a protective layer. Thus, the Examiner mistakenly considers the adhesive layer (93) of O'Brien as corresponding to the second adhesive layer of

the present invention. However, O'Brien fails to teach or suggest a layer constitution in which the adhesive layer (93) fixes a layer which supports the EAS tag (91) (namely, the protective layer (87) or the reflective layer (83')), to another layer which constitutes the optical storage device of O'Brien. Takemura et al also fails to remedy this deficiency.

It appears the Examiner's misunderstanding is caused by the location "(80)" shown under the protective layer (87) in Figure 7 of O'Brien. In fact, column 5, lines 38 to 42 and 55 to 58 of O'Brien indicate that the "optical storage substrate (80)" is a lamination body formed by laminating an intermediate laminated film and a protective layer (87), wherein the intermediate laminated film is formed by laminating a print layer (81), a reflective layer (83), and an optically-transparent substrate (85). Thus, it is understood from column 5, lines 58 to 60 of O'Brien that although the adhesive layer (93) may be adjacent to the protective layer (87), the adhesive layer (93) is **not** located on substrate (80) "via a protective layer (87)".

Further, the amendment to claim 1 further clarifies that in the present invention the reflective layer is between the transparent substrate and one of the "another substrate" and the "another layer", and therefore the embodiment shown in Figure 7 of O'Brien is outside of the scope of the present invention as recited in claim 1.

Even further, the present invention provides unexpectedly superior results in that it achieves both sufficient strength in binding between two substrates (lamination strength) and better appearance by the characteristic features of the first adhesive layer and the second adhesive layer provided as described in present claim 1. When an adhesive layer is formed on the entire surface of the layer adjacent to the adhesive layer of the optical recording medium as taught by Itoigawa, the thus obtained optical recording medium cannot possess a better

appearance because an adhesive provided in a circumferential portion of a center hole of the optical recording medium is seen from the outside. Takemura et al does not remedy this deficiency. Thus, one of ordinary skill in the art would not have been motivated to combine the references as suggested by the Examiner with a reasonable expectation of success.

Additionally, the Examiner appears to think that O'Brien teaches a first adhesive layer and a second adhesive layer similar to the present invention. However, while the first adhesive layer and the second adhesive layer of O'Brien are provided for obtaining different effects (namely, the first adhesive layer of O'Brien works to bind the print layer and the reflective layer to form the optical storage substrate, and the second adhesive layer of O'Brien works to bind an EAS tag and the optical storage substrate), both of the first adhesive layer and the second adhesive layer of the present invention work to bind the two substrates. In this connection, the cited references fail to teach obtaining a better appearance of an optical medium by providing two adhesive layers having a common function of binding the two substrates. Thus, one of ordinary skill in the art would not have been motivated to combine the references with a reasonable expectation of success.

In view of the above, the cited references do not teach or suggest all elements of the claims and therefore the claimed invention is not rendered obvious. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

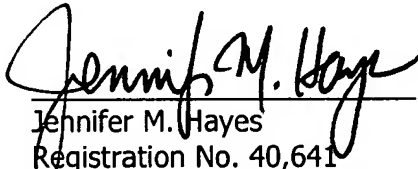
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